
Remarks:

R1 Claims 1 to 42 stand rejected.

R2 Independent claim 1 has been amended to qualify: that the method reduces repeat voicemail notifications generated by a wireless device for an unheard voicemail message of which a user of the wireless device has previously been notified, and to qualify that the wireless device compares notification information stored at the wireless device with subsequently received notification information in order to suppress further voicemail notification unless the stored and subsequently received notification information differs. Support for the repeat voicemail notification suppression amendment is found in originally filed independent claim 15. Support for the "on wireless device" qualifications is found throughout the originally filed application, for example in the Detailed Description of the Drawings from the penultimate paragraph on page 3 to and including paragraph 5 on page 5. Independent claim 1 has also been amended to qualify that the receipt of subsequent unheard voicemail message notification relates to registration of the wireless device with wireless network infrastructure, described in the penultimate paragraph on page 3 of the originally filed application. Independent claim 1 has been further amended to include a notification information update step performed by the wireless device, update step which is described in the penultimate paragraph on page 4 and shown in Figure 1 of the originally filed application.

R3 Dependent claims 2 to 4 and 12 have been amended in order to correct antecedents resulting from the amendments to independent claim 1.

R4 Claims 15 to 42 are canceled.

R5 Dependent claims 43 and 44 have been added in accordance with the Examiner's invitation to amend expressed at point 1 of the outstanding Office Action.

R6 Claims 1 to 14 and 43 to 44 are pending in the application.

R7 In paragraphs [0005], [0007], [0008], [0027], [0028], [0029], [0033], [0034], and [0035] references to 'receiving/delivering a voicemail message at/to the wireless device' have also been amended read --receiving/delivering voicemail message notification at/to the wireless device--. Support for the amendments is found in the originally filed application at paragraphs [0005], [0006], [0008], [0015] and [0027]. Figure 2 has been amended accordingly.

R8 It is submitted that no additional subject matter has been introduced by the amendment.

Arguments:

A1 Applicant has reviewed the Examiner's Response to previous Arguments on page 2 of the outstanding Office Action. Applicant respectfully disagrees with the Examiner's position.

Applicant has reviewed the Examiner's comments with respect to claims 1 to 14 wherein the Examiner appears to have engaged in a philosophical argument regarding abstract ideology. *Applicant respectfully notes that a statement of Graham factual enquiries is missing from the Examiner's articulated arguments.* Applicant respectfully submits that claims 1 to 14 are directed to inventive practical implementations as described in the originally filed application. For reasons presented herein below, Applicant respectfully submits that a person of ordinary skill in the art would not derive the same results provided by the claimed invention in claims 1 to 14

by combining Boland and Kaplan. Therefore, Applicant's previous arguments continue to be relevant and are retained on file.

In view of the Examiner's comments, Applicant, without prejudice, cancels claims 15 to 42. All previously presented arguments are retained on file, and Applicant reserves the right to address Examiner's rejections in respect of canceled claims 15 to 42 at a later date in a continuation application.

Without prejudice, Applicant proposes clarifying amendments in order to advance and refocus prosecution.

A2 Applicant notes that all pending claims 1 to 42 have been rejected under 35 U.S.C. §103(a) as stated at point 1 of the outstanding Office Action. The Final Office Action was issued following the United States Supreme Court's decision in the case of *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007). In light of the *KSR* decision, Applicant wishes to address various issues pertaining to a proper analysis under section 103.

Applicant further respectfully submits that, even after *KSR*, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by the *KSR* decision:

- (1) the USPTO still has the burden of proof on the issue of obviousness;
- (2) the USPTO must base its decision upon objective evidence, and it must support its decision with articulated reasoning (slip op. at 14);
- (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15);

(4) hindsight has no place in an obviousness analysis (slip op. at 17); and

(5) Applicant is entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

The Examiner, by citing references and asserting a reason for combining elements from the references, has elected to base the rejection upon a teaching, suggestion or motivation to select and combine features from the cited references. Applicant wishes to point out that the Supreme Court's *KSR* decision did not reject use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis, characterizing the analysis as "a helpful insight." *KSR* slip op. at 14-15.

When the Examiner chooses to base a rejection upon a teaching, suggestion or motivation analysis, the Examiner must satisfy the requirements of such an analysis. In particular, the Examiner must demonstrate with objective evidence of record and articulate a reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. E.g., *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, objective evidence found in the prior art must suggest the desirability of the combination, not merely the feasibility. *In re Fulton*, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

In order to establish a *prima facie* case of obviousness, irrespective of the rationale proposed by the Examiner in rejecting a claim, the Examiner must produce objective evidence of record from the prior art showing a reasonable expectation of success from such combination. (see MPEP2143) *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), and *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

A3 As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. §103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (A) Determining the scope and content of the prior art; and
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel.

Graham v. John Deere Co., at 17-18, 148 USPQ at 467.

A4 Regarding Examiner's objection to claims 1 to 14, Applicant respectfully submits that the Examiner's articulated objection is not sufficient to establish a *prima facie* case of obviousness for the following reasons:

In accordance with the first *Graham* factual enquiry regarding determining the scope and content of the Boland prior art, Applicant retains on file the characterization of Boland presented in the last paragraph on page 8 of Applicant's June 4, 2007 submission. Boland is characterized by Mobile Switching Center functionality used to reduce network resources by reducing network traffic between the MSC and the mobile subscriber station. Acknowledgements sent by the mobile subscriber station to the MSC represent an essential element to the MSC functionality described by Boland. The MSC, Visited Location Registers, Home Location Registers, and MSC implemented functionality are all essential elements of the subject matter described by Boland. It appears that the Examiner agrees with the above assessment of the Boland prior art as articulated in the last paragraph on page 3 and in the first paragraph on page 4 of the outstanding

Office Action. Furthermore, at point 2 of the outstanding Office Action the Examiner states “Boland teaches a message waiting notification update system”. Applicant respectfully submits that the system in the context described by Boland does not include a wireless device.

In accordance with the second *Graham* factual enquiry regarding ascertaining differences between the claimed invention and the cited prior art the Examiner simply states at second paragraph on page 4 of the outstanding Office Action that “Boland does not disclose the information being contained at the mobile device”. Applicant respectfully submits that Boland does not teach any of a multitude of elements of the claimed invention. Independent claim 1 is not directed to method steps performed by wireless network infrastructure such as MSCs, VLRs, HLRs, etc. The wireless device functionality claimed is only responsive to unheard voicemail message notifications received at the wireless device from wireless network infrastructure. Claim 1 is directed to storage of unheard voicemail message notification information at the wireless device, comparison of unheard voicemail message notification information at the wireless device, conditional output of voicemail notifications to attract the user's attention, and update of unheard voicemail message notification information stored at the wireless device. The wireless device functionality claimed in independent claim 1, is directed to reducing repeat unheard voicemail notifications output otherwise employed to attract the attention of the user of the wireless device. Clearly Boland teaches away from the claimed invention.

Concerning Kaplan, column 7 lines 31 to 33, column 8 lines 39 to 48, column 8 lines 55 to 64 describe functionality wherein any and all received unheard voicemail message information “enables” triggers voicemail message notification to the user. Therefore, Applicant respectfully submits that Kaplan teaches away the claimed invention by teaching issuing repeat voicemail

notifications to attract the user's attention in direct contravention to the solution provided the claimed invention.

In accordance with the third *Graham* factual enquiry regarding resolving the level of ordinary skill in the pertinent art, Applicant respectfully submits that a person of ordinary skill in the art reading Boland would understand that in adapting the Boland described functionality to "provide local access to information regarding voicemail and messaging" would necessitate conveyance of message waiting notifications to the mobile subscriber station in direct contravention to the desired result stated in Boland of reducing messaging traffic between the MSC and the mobile subscriber station. The same argument has been made on page 9 of the Applicant's June 4, 2007 submission. Furthermore, Applicant respectfully submits that a person of ordinary skill in the art would be unable to combine Boland and Kaplan in accordance with the Examiner's suggested combination with a reasonable expectation of success because the Examiner failed to produce prior art teaching of the necessary steps involved in providing the MSC with the locally stored information for the MSC to exercise its decision. Yet further, the Examiner failed to produce objective evidence of record, from the cited prior art, showing how the essential acknowledgement receipt functionality at the MSC described in Boland would work in the combination with reasonable expectation of success.

Therefore Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness with respect to independent claim 1, by failure to produce objective evidence of record from the cited prior art showing a reasonable expectation of success from the combination proposed by the Examiner.

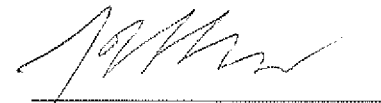
A5 Dependent claims 1 to 14, 43 and 44 variously depend directly and/or indirectly from independent claim 1 and therefore incorporate all respective limitations of independent claim 1. Therefore Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness in respect of dependent claims 1 to 14, 43 and 44 by failure of produce prior art teaching of each and every claimed element and step thereof, by failure to produce objective evidence of record from the cited prior art showing a reasonable expectation of success from the combination proposed by the Examiner.

A6 In *In re Oetiker*, 977, F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), the Federal Circuit stated that “[i]f the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.”

Applicant respectfully submits that the above arguments raise questions regarding the establishment of a *prima facie* case of unpatentability.

Reconsideration and allowance are respectfully requested.

Respectfully submitted,
for the Applicant



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